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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,992	08/06/2003	James G. McErlean	103864.139US1	7424
28089	7590	05/18/2006	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP 399 PARK AVENUE NEW YORK, NY 10022				DESAI, HEMANT
ART UNIT		PAPER NUMBER		
		3721		

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/634,992	MCERLEAN ET AL.
	Examiner Hemant M. Desai	Art Unit 3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 August 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 24-29 and 52-71 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-23 and 30-51 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1-71 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/3/2004</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-51 and 60-71, drawn to system and method for emptying containers, classified in class 414.
 - II. Claims 52-59, drawn to a prescription filling and packaging system, classified in class 53, subclass 244.

If applicant elects Group I, it will be further restricted between the two following sub-groups:

- IA. Claims 1-23 and 30-51, drawn to a system for emptying containers, classified in class 414, subclass 412.
- IB. Claims 24-29 and 60-71, drawn to a method for emptying containers, classified in class 414, subclass 810.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed in claims 1-51 and 60-71, does not require at least one dispensing machine that automatically counts and dispenses pharmaceuticals from the storage container and

into bottles in accordance with prescription orders comprising at least one prescription of the subcombination as claimed in claims 52-59. The subcombination has separate utility such as dispensing and packing the prescription in accordance with prescription orders comprising at least one prescription.

3. Inventions IB and IA are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another and materially different apparatus such as a control system for controlling the operation of the gripper unit and the cutter or emptying the containers by hand.

4. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Irah Donner on 5/4/2006 a provisional election was made without traverse to prosecute the invention of Group IA, claims 1-23 and 30-51. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-29 and 52-71 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the

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requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

MISCELLANEOUS

7. Claims 30-33, 35-36 are written in "means plus function" form and since they meet the analysis set forth in MPEP 2181, the Examiner assumes that applicant wishes to invoke 35 USC 112, paragraph 6.

Claim Objections

8. Claim 20 is objected to because of the following informalities: Claim 20 should depend on claim 19. For examination purpose Examiner assumes that claim 20 is depending on claim 19. Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-3, 7-8, 10-16, 19-20, 30-32, 34, 37-39, 43, 45-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Browning (6715266).

Browning discloses an automated system for emptying contents (11, fig. 6) of pharmaceutical containers (10) including medications (11), comprising a gripper unit (140, 144, figs. 7A, 7-B) for receiving and holding a pharmaceutical container (10, figs. 1A, 2-5), a cutter (162, fig. 3) for cutting the pharmaceutical container, a rotating unit (150, figs. 7A-7B) operable with the gripper unit (144) that rotates at least a portion of the gripper unit to empty the contents of the pharmaceutical container, which meets all the claimed limitations.

Regarding claims 2 and 43, Browning discloses a robot (120, 122, figs. 2-6) for placing the pharmaceutical container in the gripper unit.

Regarding claim 3, Browning discloses a conveyor (discharge chute 228, fig. 10B) for transporting the pharmaceutical container in proximity to the robot (102, fig. 1B, see col.5, lines 45-49).

Regarding claims 7 and 45, Browning discloses that the contents of the pharmaceutical container are emptied into a bulk-up container (260, fig. 10A).

Regarding claim 8, Browning discloses that the bulk-up container (260) comprises a substantially uniform sized container (20, fig. 11) to facilitate the automated dispensing of the medications.

Regarding claim 9, Browning discloses that the cutter is an ultrasonic cutter.

Regarding claim 10, Browning discloses that the cutter comprises a blade (162, fig. 3) that moves in a direction substantially parallel to a belt of the conveyor.

Regarding claims 11 and 46, Browning discloses that a rod less air cylinder is used to facilitate movement of the cutter.

Regarding claims 12-13, 34 and 47-48, Browning discloses an arm that rotates to a first position to receive the cut portion of the pharmaceutical container (see fig. 4), and a second position to place the cut portion in a waste repository (see fig. 5).

Regarding claim 14, Browning discloses that the cut portion is released scrap bin (184, fig. 1A).

Regarding claims 15 and 49, Browning discloses a scrap chute (184) that receives a portion of the pharmaceutical container subsequent to emptying the contents of the pharmaceutical container.

Regarding claim 16, Browning discloses that the scrap chute (182, figs. 1A-1B) is in a distal position with respect to the gripper unit prior to emptying the contents of the pharmaceutical container, the scrap chute moving to a proximal position with respect to the gripper unit to receive the portion of the pharmaceutical container held by the gripper unit subsequent to emptying the contents of the pharmaceutical container, the scrap chute returning the distal position to place the portion the pharmaceutical container held by the gripper unit in a scrap bin (184).

Regarding claims 19 and 20, Browning discloses that the gripper unit comprises first and second interlocking fingers (see col. 3, lines 30-33).

Regarding claim 30, Browning discloses, as mentioned above, the automated system for emptying the contents of pharmaceutical containers, comprising means (140, 144) for receiving and holding a pharmaceutical container, means (160) for cutting the pharmaceutical container, means for rotating (150, fig. 7A) at least a portion of the means for receiving and holding to empty the contents of the pharmaceutical container.

Regarding claim 31, Browning discloses means (120) for placing the pharmaceutical container in the means for receiving and holding.

Regarding claim 32, Browning discloses means for transporting (discharge chute 228) pharmaceutical containers in proximity to the means for receiving and holding.

Regarding claim 37, Browning, as mentioned above, discloses the automated system for emptying the contents of pharmaceutical containers, including medications, comprising a gripper unit for receiving and holding a pharmaceutical container, a cutter

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for cutting the pharmaceutical container and a control system (280, fig. 10A) for controlling the operation said gripper unit and said cutter.

Regarding claim 38, Browning discloses a rotating unit (150), operable with the gripper and the control system that rotates at least a portion of the gripper unit empty the contents of the pharmaceutical container (see col. 4, lines 1-5, figs. 4-5).

Regarding claim 39, Browning discloses the control system. Therefore a keyboard, control logic, a display, and a processing unit in inherent part of the control system.

Regarding claim 43, Browning discloses o claim 37, further comprising a robot, interfacing with said control system, for placing the pharmaceutical container said gripper unit. 20 44. The system according to claim 43, further comprising a vision system, utilized by said robot and interfacing with said control system, to determine the position of the pharmaceutical containers. 25 45. The system according to claim 37, wherein the contents of the pharmaceutical container are emptied into a bulk-up container.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 4-6, 33 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browning in view of McGrath et al. (6494017).

Browning, as mentioned above, discloses all the claimed limitations, except for a vision system (means for viewing). However, McGrath et al. teach a vision system (3, fig. 20) for rejecting out of shape containers from the conveyors (see col. 4, lines 37-67). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide vision system as taught by McGrath et al. in the automated system for emptying contents of Browning for rejecting out of shape containers from the conveyors.

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Browning in view of Blaimschein (5318420).

Browning, as mentioned above, discloses all the claimed limitations, except for an ultrasonic cutter. However, Blaimschein teaches an ultrasonic cutter to permit an economical and accurate cutting of work-pieces made of any desired polymers or fiber-reinforced polymers with a high efficiency and a low loss of material. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the ultrasonic cutter as taught by Blaimschein in the automated system for emptying contents of Browning to permit an economical and accurate cutting of work-pieces with a high efficiency and a low loss of material.

14. Claims 17-18, 35 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browning in view of Kitamura et al. (5423216).

Browning, as mentioned above, discloses all the claimed limitations, except for a sensor system to determine when the contents of the pharmaceutical container are no longer being emptied. However, Kitamura et al. teaches sensor system (7, fig. 4;

comprises a light emitter, see col. 6, lines 67-68; col. 7, lines 1-2) to determine the contents of funnel (4, fig. 4) are no longer being emptied to activate the scrapper assembly (8, fig. 4). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide sensor system to determine when the contents of the container are no longer being emptied as taught by Kitamura et al. in the automated system for emptying contents of Browning to determine when the contents of the pharmaceutical container are no longer being emptied to activate the discharge chute traverse assembly (180) to expose the bottle to expose the bottle discharge chute (184).

15. Claims 21-23, 36 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browning in view of Yuyama et al. (6644504).

Browning, as mentioned above, discloses all the claimed limitations, except for detection system to detect the container is no longer being held by the gripper unit. However, Yuyama et al. teaches a detection system (sensor 8a, fig. 2a) to detect the container (11, fig. 2a) is no longer being held by the vessel holder (8, fig. 2a). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide sensor system to detect the container is no longer being held by the gripper unit as taught by Yuyama et al. in the automated system for emptying contents of Browning to detect the container is no longer being held by the gripper unit.

Regarding claim 23, Browning discloses that the pharmaceutical container can be of different shapes and sizes (see col. 3, lines 30-33).

16. Claims 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browning in view of Coughlin (2004/0059463).

Browning, as mentioned above, discloses all the claimed limitations, except for an indicia reader that interfaces with the control system. However, Coughlin teaches an indicia reader (282, fig. 13), which interfaces with control system (28, figs, 9 and 13) to retrieve the information about pharmaceutical (paragraph 0031). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the indicia reader that interfaces with the control system as taught by Coughlin in the automated system for emptying contents of Browning to retrieve the information about pharmaceutical.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant M. Desai whose telephone number is (571) 272-4458. The examiner can normally be reached on 7:00 AM-5: 30 PM, Mon-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hemant M. Desai

Hemant M Desai
Examiner
Art Unit 3721

HMD